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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,754	01/27/2004	Andrew Perkins	A-75001	2266

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EXAMINER	
TRUONG, THANH K	

ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/766,754	PERKINS, ANDREW	
	Examiner	Art Unit	
	Thanh K. Truong	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 January 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *11-4-05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to applicant's amendment received on January 18, 2006.

2. Applicant's cancellation of claims 21-23 is acknowledged.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 18-33 of copending Application No. 10/946,715. Although the conflicting claims are not identical, they are not patentably distinct from each other, because the difference between both of the applications is that in the present application, the means engagable to produce a partial tearing on the material is applied at the edge portion, and in the copending application, the means engagable to produce a partial tearing on the material is applied at the central portion. It would have been obvious to one skilled in the art to have

positioned the means engagable to produce a partial tearing on the material in any location, as they are obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1, 3, 5-7, 9, 11, 13-15, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss et al. (6,582,800) in view of Bolton (4,493,684).

Fuss et al. discloses an apparatus and method for making a packing material in the form of a string of air-filled packing cushions with rows of perforations extending across the material between the cushions, comprising: means (43, 44) for feeding superposed layers of film material having longitudinal spaced, transversely extending rows of perforation along a path, means (89) for injecting air between the two layers of film material, means (93) for sealing the layers of film material together to form air-filled cushions between the rows of perforations.

Fuss et al. disclose the claimed invention, but did not expressly disclose the means for partially tearing the material along the edge portion of the rows of

perforations to facilitate the tearing a desired number of the air-filled cushions from the string.

Bolton discloses (figures1-4) an apparatus and the method comprising: means (51) engagable with an edge portion of the material (10) for feeding the material at a predetermined speed, and a tear roller (55) having a surface that rotates faster than the predetermined speed (column 2, lines 33-35) and is intermittently engagable with the edge portion for exerting an abrupt periodic pull on the material which produces a partial tearing of the material along the rows of perforations (column 2, lines 33-35 and column 3, lines 37-39).

Bolton further discloses: the means for feeding the material at a predetermined speed comprises a feed roller (51) with a surface in continuous driving engagement with the material (figure 3); and the tear roller rotates faster than the feed roller (column 2, lines 33-35).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Fuss et al. apparatus and method by incorporating the apparatus and the method for partially tearing the material along the edge portion of the rows of perforations as taught by Bolton, in order to provide means for making a packaging system which is capable of more rapid and economic operation.

7. Claims 2, 4, 8, 10, 12, 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss et al. (6,582,800) in view of Bolton (4,493,684) and further in view of Meschi (5,230,453).

As discussed above in paragraph 6 of this office action, the combination of the references of Fuss et al. and Bolton disclose the claimed invention, but do not expressly disclose that the tear roller has an arcuate section and a section adjacent to the arcuate section, which remains out of driving engagement with the material, and the tear roller is larger in diameter than the feed roller.

Meschi discloses (figure 5) an apparatus and the method in which the tear roller (125, 126) has an arcuate section and a section adjacent to the arcuate section (127, 128), which remains out of driving engagement with the material, and the tear roller is larger in diameter than the feed roller (figure 5). The Meschi apparatus and method provides an efficient means to periodically cause a substantial tensioning on the material sheet to produce a tearing at the transversal pre-pierced straight line (column 6, lines 1-11).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have further modified the Fuss apparatus and method by incorporating the tear roller as taught by Meschi, providing an efficient means to periodically cause a substantial tensioning on the material sheet to produce a tearing at the transversal pre-pierced straight line.

Response to Arguments

8. Applicant's arguments filed January 18, 2006 have been fully considered but they are not persuasive.

9. In response to the Applicant's argument that Bolton and Meschi are not concerned with air-filled packaging cushions, the examiner would like to point out that:

Bolton is relied upon for the teaching of the partially tearing the material along the edge portion of the rows of perforations; and

Meschi is relied upon for the teaching of applying the tear roller that has an arcuate section and a section adjacent to the arcuate section, which remains out of driving engagement with the material.

10. In response to Applicant's argument that Bolton's rollers must be moved into and out of contact with the bags whenever a tear is desired, and in Meschi, "the material is completely severed rather than being only partially torn as in Applicant's invention", it must be noted that Bolton and Meschi are relied upon for the teaching as discussed in paragraph 9 above. Furthermore, Bolton and Meschi disclose the claimed limitations as recited. The fact that they disclose additional structure limitations not claimed is irrelevant.

11. In response to the Applicant's argument that:

> *"While Fuss et al. may be concerned with the manufacture of air-filled packing cushions, it does not teach or even remotely suggest the pre-tearing of strings of such cushions to facilitate their subsequent separation in use. In fact, non of the references recognizes or suggests the desirability of doing so, and the only motivation for the pre-tearing of strings of air-filled packing cushions is in applicant's own disclosure and claims".*

In other words, Applicant contends that the examiner's conclusion of obviousness is based upon improper hindsight reasoning; however, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tkt
March 28, 2006.

LOUIS K. HUYNH
PRIMARY EXAMINER